

REMARKS

Applicant thanks the Examiner for the thorough consideration given the present application and for acknowledging the claim for foreign priority. With regard to the issue raised in item 1 on page 2 of the Office Action, attorney for Applicant attaches a substitute Declaration that correctly identifies Applicant's priority application as JP 11-256084.

Claims 1-20 are pending. Claim 1 is amended to preclude any interpretation thereof under 35 U.S.C. §112, sixth paragraph.

Applicant traverses the rejection of claims 1-3, 6-8, 12, 15-17, and 20 as being obvious over Lathrop (U.S. Patent No. 5,097,427) in view of Curry (U.S. Patent No. 5,696,604).

Independent claim 1 requires mapping an optical image onto a warped line pattern. Independent claim 12 requires a processor to be programmed to warp an initial line pattern to produce a warped line pattern and to map an optical image onto the warped line pattern to produce an engraving-style halftone image. Independent claim 20 defines a computer-readable medium carrying instructions for warping an initial line pattern to produce a warped line pattern and mapping an original image onto the warped line pattern to produce an engraving-style halftone image.

Applicant does not agree that Lathrop and Curry make the subject matter of independent claims 1, 12, and 20 obvious.

Applicant does not claim to be the inventor of image warping. The sentence bridging pages 7 and 8 of the application as filed indicates image warping is old. Applicant has defined in the independent claims a method and system for producing an engraving-style halftone image through the use of engraving and warping.

While Curry may disclose producing a computer-generated engraving plate formed from halftone data, there is no reason why one of ordinary skill in the art would have combined warping and Curry to arrive at the combination of steps of claim 1 or the system of claim 12 or the computer-readable medium of claim 20. The Office Action alleges that Lathrop and Curry are combinable because they are from the same field of endeavor (digital image processing). The Examiner says there would have been motivation to combine Lathrop and Curry to provide a desired texture pattern that can be stored and selected for use in a system as disclosed by Lathrop. However, Lathrop is not concerned with providing an engraving-style image.

The Office Action does not explain how one of ordinary skill in the art would have been able to modify Lathrop as a result of the disclosure in Curry. The test for patentability is not mere motivation. There must be some indication in Curry as to how one of ordinary skill in the art would have modified Lathrop to arrive at an engraving-style halftone image, as claim 1 requires, or how one of ordinary skill in the art would have modified Lathrop to

map the original image onto the warped line pattern to produce an engraving-style halftone image, as claim 12 requires, or to provide a computer-readable medium that carries instructions for producing and engraving a halftone image by mapping an original image onto a warped line pattern.

In other words, in order to show obviousness in the present case, the Office Action must do more than merely indicate the desirability of combining the references. The burden is on the Examiner to show how one of ordinary skill in the art would have combined the references, because of the complexity of the problems associated with warping an image to obtain an engraved image.

The Curry reference does not indicate how to perform engraving. The Examiner alludes to column 3, lines 63-65, that merely mentions "engraving plate devices" but gives no details as to how engraving plate devices function. Applicant does not claim to be an inventor of engraving plate devices. However, Applicant has invented a way to combine warping and engraving to produce a highly desirable result. To establish a *prima facie* case of obviousness, the Examiner must indicate how one of ordinary skill would have combined Lathrop and Curry to arrive at the combinations defined by claims 1, 12, and 20.

In particular, how do Lathrop and Curry enable one of ordinary skill to produce an engraving-style halftone image by

mapping an original image onto a warped line pattern, as claims 1, 12, and 20 require? In other words, what steps does Curry disclose that would teach one of ordinary skill how to modify Lathrop to produce an engraving-style halftone image?

Because the Examiner has not attempted to answer these questions, the rejection of independent claims 1, 12, and 20 is incorrect. The Examiner has merely said the combinations of claims 1, 12, and 20 are obvious because he found two references that might indicate warping and engraving through the use of computers is old. The Examiner has not indicated how to combine these references to arrive at the claimed subject matter.

Because the combination of Lathrop and Curry is improper for independent claims 1, 12, and 20, claims 2, 3, 6-8, and 15-17 are also allowable.

Applicant traverses the rejections of claims 4, 5, 9, 13, 14, and 18 as being unpatentable over Lathrop, Curry, and Arnold (U.S. 5,929,866) and of claims 18 and 19 as being unpatentable over Lathrop in view of Curry and Smitt (U.S. 5,988,504). Neither Arnold nor Smitt cures the foregoing deficiencies in the combination of Lathrop and Curry with regard to independent claims 1 and 12, upon which claims 4, 5, 9-11, 13, 14, 18, and 19 depend.

Because Arnold has nothing to do with either warping or engraving, it is irrelevant to claims 4, 5, 9, 13, 14, and 18. With regard to Smitt, the Office Action says a warped image is

inherently a weighted image, because a weighting scheme is based on the type of image warping desired. It appears that the Examiner is speculating on this issue. The Examiner is reminded of the burden for establishing inherency.

The fact that a certain result or characteristic **may** occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578, 581-82, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981). To establish inherency, extrinsic evidence must make clear that the missing descriptive matter is **necessarily** present in the thing described in the reference and that it would be so recognized by persons of ordinary skill in the art. Inherency may not be established by possibilities or probabilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *In re Roberston*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). In relying upon a theory of inherency, the Examiner must provide a basis in fact or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the prior art. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (B.P.A.I. 1990). Hence, the Examiner must provide evidence or rationale to support the

position that a weighting scheme is necessarily based on the type of image warping desired.

Accordingly, the rejections of claims 4, 5, 9-11, 13, 14, 18, and 19 are improper and should be withdrawn.

In view of the foregoing amendments and remarks, favorable reconsideration and allowance are deemed in order.

To any extent necessary, Applicant hereby requests an extension of time in which to file this paper. The Commissioner is hereby authorized to charge any omitted fees, including extension of time and extra claims fees, to Deposit Account 07-1337.

Respectfully submitted,

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